

REMARKS

Applicants respectfully traverse and request reconsideration.

Claims 5, 8-9, 10-13 and 19-20 stand rejected under 35 U.S.C. §112, 2nd paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 10-13 stand rejected as allegedly reciting both a product and a process rendering the claims allegedly vague and indefinite. However, Applicants respectfully submit that the claim form is not a product and process combination. It is respectfully submitted that the form complies with the Patent Office's computer related invention guidelines and that the body of the claim is not claiming a process but to the contrary, claims the function of the stored executable instructions that are stored in the memory. For example, the guidelines state that a computer memory encoded with executable instructions representing a computer program that can cause a processor or processors to function in a particular fashion are patentable. As such, the language of the claim refers to the functions of the data within the memory and as such is in proper form. (See also *In re: Beauregard* 53 F.3d. 1583(Fed. Cir. 1995)). Applicants respectfully request that the rejection be withdrawn.

As to claims 5, 8, 13 and 19, it is alleged that this language fails to particularly point out and distinctly claim the invention. Applicants respectfully submit, however, that the claim language appears to be definite as recognized in the first office action which initially allowed these claims (claims 5 and 8). Applicants are unable to determine the alleged indefiniteness based on the rejection, since it does not indicate what appears to be indefinite. Since the claim indicates that, during a second more-preferred SID acquisition sequence, an acquisition of a first more-preferred stored SID element is attempted in addition to repeated attempts to require a second more-preferred stored SID element and a single acquisition attempt of at least one less-

preferred stored SID element. Accordingly, Applicants respectfully submit that the claim describes how the second more-preferred SID acquisition sequence is carried out.

Claims 10-13 stand rejected under 35 U.S.C. §101 as allegedly claiming multiple classes of statutory subject matter. Applicants respectfully reassert the relevant remarks made with respect to the 35 U.S.C. § 112 rejection and as such, respectfully request that this rejection be withdrawn.

Claims 1-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hooper et al. The office action notes that the claim does not require that the more-preferred stored SID element corresponds to a home system or most-preferred SID element and thus Applicants' arguments were allegedly unpersuasive. Applicants have added new claim 21 which is dependent upon claim 1 which indicates that the more-preferred stored SID element corresponds to the SID element for a home system. However, Applicants respectfully submit for at least the reasons below that the pending claims are also allowable.

The office action specifically cites column 9, line 46 to column 10, line 65 of Hooper as allegedly teaching a second more-preferred SID acquisition sequence that includes repeatedly attempting acquisition of the more-preferred SID element that was attempted to be acquired during the first more-preferred SID acquisition sequence. However, Applicants are unable to find such a teaching in the cited portion. For example, the cited portion refers to a single acquisition sequence technique that detects and classifies systems that transmit within a predefined frequency range until all frequencies within the pre-selected frequency range have been selected. (See column 10, lines 44-46). If after the entire frequency range has been scanned, a most-preferred system has not been detected then the mobile terminal selects a preferred system from a lesser preferred system. (See column 10, lines 46-52). There is no teaching of a second more-preferred SID acquisition sequence. In addition, there is no teaching

of a second more-preferred SID acquisition sequence that repeatedly attempts acquisition of the same more-preferred stored SID element, that was attempted to be acquired during the first more-preferred SID acquisition sequence. An acquisition sequence as described in Hooper is a sequence that detects and classifies all frequencies within a pre-selected frequency range. During this process, there is not a second sequence nor a repeated attempt for the same SID element as required by the claim. Accordingly, Applicants respectfully submit that the claims are in condition for allowance. As such, as to claims 1, 6, 8, 10, 14 and 19, Applicants respectfully submit that the claims are in condition for allowance.

The dependent claims add additional novel and non-obvious subject matter and are therefore also allowable.

Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

Dated: 5/12/06

By: Christopher J. Reckamp
Christopher J. Reckamp
Reg. No. 34,414

Vedder, Price, Kaufman & Kammholz, P.C.
222 North LaSalle Street
Chicago, Illinois 60601
PHONE: (312) 609-7599
FAX: (312) 609-5005